

Serial No.: 08/777,958
Art Unit: 2743

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response and a rear seat frequency response constructed and arranged to be free of an undesirable peak in the rear seat frequency response of said vehicle between 80-100 Hz and free of an undesirable hole between 60-80 Hz in the front seat frequency response of said vehicle.

REMARKS

Claims 6-10 have been added to particularly point out and distinctly claim subject matter regarded as the invention. Claims 1-5 are presented for reconsideration without amendment in the light of the following authorities and remarks.

1,2. Claims 1-5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Newcomb. Regarding claims 1-4, the reference is said to disclose an audio speaker system for a vehicle in a magazine article. The woofer is said to be mounted in an enclosure and placed in the trunk, clear of the rear deck, as said to be shown. However, the reference is said to fail to explicitly show that the woofer is outside the spare-tire compartment. It is said to be well-known in the art that the location of the woofer is generally not strictly limited to a specific location for a high fidelity stereo sound system because the low frequency sound signal produced by the woofer does not carry the spacial information as required for portraying the stereophonic sound image. Therefore, it is said the woofer can be placed almost anywhere around the listener within a reasonable distance. The reference is said to show the woofer inside the spare-tire compartment. However, it is

Serial No.: 08/777,958
Art Unit: 2743

Patent

said that one would have expected that the woofer can be placed anywhere, including the rear trunk corner at the rear of the vehicle, inside the trunk because altering the location of the woofer inside the trunk is said to not produce any acoustically different sound effect. It is said it would seem to be reasonable for one skilled in the art to place the woofer outside the spare-tire compartment, such as at the rear trunk corner, if one wants to keep the spare-tire inside that compartment. It is said it would also be common sense to not place the woofer in the center of the trunk, for example, right above the spare-tire compartment, so one can put luggage, shopping bags or other articles inside the trunk. Thus, it is said it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system as said to be taught in the reference by placing the woofer inside the trunk clear of the rear deck, outside the spare-tire compartment and at the rear corner, since it is said to have been held to be within the general skill of a worker in the art to rearrange the location of the woofer as a matter of design choice, citing *In re Japiksen*, 86 U.S.P.Q. 70 (C.C.P.A 1950).

Regarding claim 5, with the woofer mounted inside the trunk as said to be taught in the reference, not conventionally mounted at the rear deck, it is said the claimed frequency responses are inherently met. These grounds of rejection are respectfully traversed.

Serial No.: 08/777,958
Art Unit: 2743

Patent

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). The reference must suggest the desirability of modifying what is there disclosed to meet the terms of the claim being rejected. Nothing in the reference suggests the desirability of modifying what is there disclosed to meet the terms of the claims being rejected.

The reference discloses:

The equipment in the trunk also does a disappearing act when panels are in place. For example, four a/d/s/ S10 10-inch subwoofers in the floor of the trunk can be covered. Using fiberglass, Rivera divided the spare-tire compartment into four separate sealed enclosures, each with 0.8 cubic feet of air space.

"The space I have in the trunk is really usable; I crossed the country with all my luggage and all my tools," said Rivera, who recently relocated to Southern California from Boston to look for work.

That teaching hardly suggests the desirability of having the audio speaker system comprise at least one low frequency speaker disposed within the trunk of the vehicle at the trunk rear in a location spaced from the passenger compartment by the portion of the trunk extending to the front of the vehicle such that the at least one speaker is clear of the rear deck above the trunk floor and outside the spare-tire compartment when an important aspect of what the reference discloses is to have the "equipment in the trunk . . . [do] a disappearing act when panels are in place" by having

Common
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Serial No.: 08/777,958
Art Unit: 2743

Patent

"four a/d/s/ S10 10-inch subwoofers in the floor of the trunk . . . covered." Nor is there the slightest suggestion of having the at least one speaker exposed in a rearward section of the trunk occupying negligible useful trunk volume causing a smaller decrease in calculated trunk volume than would occur with the one speaker mounted in the rear deck as called for by claim 2 or having the at least one speaker disposed in a rear trunk corner at the rear of the vehicle as called for by claim 3.

The Examiner cannot identify a single word, phrase, clause or sentence in the reference which suggests the desirability of modifying what is there disclosed to meet the terms of the claims being rejected.

What the Examiner is doing is using the disclosure in this application as a blueprint or template for proposing modifications to what the reference discloses in an attempt to meet the terms of the claims being rejected. This hindsight proposed reconstruction of the prior art reference cannot be used as a basis for rejecting claims.

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.¹⁵ This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."¹⁶ *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992).

¹⁵ *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *Interconnect Planning Corp.*

Serial No.: 08/777,958
Art Unit: 2743

Patent

v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

¹⁶ *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600.

The Examiner cannot point to a single word, phrase, clause or sentence in the reference that remotely suggests the desirability of modifying what is there disclosed to meet the terms of the claims being rejected.

The reliance on *In re Japiksen*, 86 U.S.P.Q. 70 (C.C.P.A. 1950) is inapposite. That case does not remotely support the statement that "it has been held to be within the general skill of a worker in the art to rearrange the location of the woofer as a matter of design choice." What the court actually said was, "We do not find in the reasons of appeal any allegation of error as to the holding so made, and, it may be said, we discern no reason for disagreeing with such holding." *Id.* 73. The court was there dealing with a contention of inoperativeness of the reference relied upon where operativeness was clear to those skilled in the art. Furthermore, this 1950 case was decided before the Patent Act of 1952 authorizing rejections only if the differences between the reference and the invention are such that the subject matter as a whole, embracing not only structure, but also advantages achieved, would not have been obvious to a person of ordinary skill in the art at the time the invention was made from the prior art being relied upon, here the reference. That is the test under section 103, not whether it is "within the general skill of a worker in the art to rearrange the location of the woofer as a matter of design

should have been clearly obvious to one of ordinary skill

Serial No.: 08/777,958
Art Unit: 2743

Patent

choice." Reference to "design choice" is a conclusion not a reason for rejection. In *In re Garrett*, 33 PTCJ 43 (BPA&I, September 30, 1986) the Board criticized the Examiner's statement that the proposed modification would have been "an obvious matter of engineering design choice" as a conclusion, not a reason, in reversing the section 103 rejection.

Reason is to save the complexity of providing fuel space for hypox and the above

Regarding claim 5, there is not the slightest suggestion that the vehicle is characterized by a front seat frequency response and a rear seat frequency response constructed and arranged to be free of an undesirable peak in the rear seat frequency response of the vehicle between 80-100 Hz and free of an undesirable hole between 60-80 Hz in the front seat frequency response of the vehicle described in the paragraph beginning at line 11 on page 4 of the specification.

Instead of relying upon a 1950 decision before the Patent Act of 1952, the Examiner should follow the rule in *Gordon* announced by the Federal Circuit Court of Appeals that the reference must suggest the desirability of modifying what is there disclosed to meet the terms of claims being rejected on a single reference.

We take this occasion to explain what precedents are considered binding in proceedings in the Patent and Trademark Office (PTO). Where the Court of Appeals for the Federal Circuit has addressed a point of law in a published opinion, the Federal Circuit's decision is controlling. Similarly controlling are decisions considered to be binding precedent by the Federal Circuit, i.e., decisions of the former Court of Claims

Serial No.: 08/777,958
Art Unit: 2743

Patent

and the former Court of Customs and Patent Appeals, as well as the former Customs Court. See *South Corp. v. United States*, 690 F.2d 1368, 215 USPQ 657 (Fed. Cir. 1982) (in banc); *Bar Zell Expeditors, Inc. v. United States*, 698 F.2d 1210, 1211 n. 4 (Fed. Cir. 1983). In those relatively rare cases where the Federal Circuit has not addressed an issue, but there is "authorized published" Board precedent, that published Board precedent is binding on panels of the Board and Examiners in the Patent Examining Corps. *Ex parte Holt*, 19 U.S.P.Q. 2d 1211, 1214 (BPA&I 1991).

Accordingly, withdrawal of the rejection of claims 1-5 as unpatentable over the reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the reference regarding as suggesting the desirability of modifying what is there disclosed to meet the terms of the claims being rejected.

New claims 6-10 are dependent upon and include all the limitations of claim 1 and further recite the feature set forth in the paragraph beginning at line 21 at page 2 of the specification regarding absence of holes in the rear deck. In the absence of pertinent prior art, these claims are properly allowable in this application.

In view of the foregoing authorities, remarks and the inability of the prior art to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. Should the Examiner believe this application is not in

Serial No.: 08/777,958
Art Unit: 2743

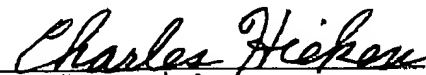
Patent

a condition for allowance, she is respectfully requested to telephone the undersigned attorney at (617) 521-7014 to discuss what steps she believes would place the application in a condition for allowance.

Please apply any charges not covered, or any credits, to Deposit Account 06-1050, Order No. 02103/211002.

Respectfully submitted,
FISH & RICHARDSON P.C.

Date: FEB 26 1998


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